THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MIZUO SOEDA, YOCHI YUZA, TAKEO ITO, KAZUE WATANABE
TED W. BUSH, MARTIN GREEN and JOHN M. BRANAN, JR.

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Appeal No. 96-1127
Application No. 07/975,587[1]

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH and JOHN D. SMITH, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 8, the only claims pending in the application.

THE INVENTION

The invention relates to a class of carbon blacks having specified properties, which

[1] Application for patent filed March 21, 1994.

are well suited for use in rubber compositions. These carbon blacks are said to impart a combination of improved abrasion resistance and reduced hysteresis to rubber compositions, particularly passenger car tires, in which they are incorporated. According to appellants, passenger car tires produced from rubber compositions incorporating these carbon blacks have (1) improved abrasion resistance, increasing the tread wear of the tire; and (2) lower rolling resistance, resulting from lower hysteresis, improving the fuel economy of a vehicle using the tires. Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

> 1. A carbon black having a N_2SA of at least 100 m^2/g; a CDBP of at least 105 cc/100g, a TINT (Tint Value) of from 90 to 140; a Dmode (nm) $ 218 - 1.12 (TINT); and a) D50/Dmode ratio of from 0.6 to 0.8.

THE ISSUE

The issue presented for review is whether the examiner erred in rejecting claims 1 through 8 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,124,396, issued June 23, 1992, to Branan, et al. (Branan).

DISCUSSION

In the Appeal Brief, page 3, appellants state that "[c]laims 1-8 stand, or fall, together for consideration of the 35 U.S.C. § 103 issue." Accordingly, for the purposes of this appeal, we shall treat claims 2 through 8 as standing or falling together with claim 1.

Having carefully considered the respective positions set forth by appellants and the examiner, we find no error in the examiner's determination that claim 1 is unpatentable under 35 U.S.C. § 103 over Branan.

The following Table **I** compares the properties of appellants' carbon black recited in claim 1 with the properties of Branan's carbon black set forth in column 3, lines 32 through 36.

Table **I**

Property	Branan	Claim 1	Comment
N_2SA (m^2/g)	120 - 180	$ 100	within claimed range
CDBP (cc/100g)	95 - 120	$ 105	overlapping ranges
TINT	96 - 176*	90 - 140	overlapping ranges
Dmode (nm)	66 - 125@	61 - 118#	overlapping ranges
) D50/Dmode	0.8 - 1.05	0.6 - 0.8	same end point & overlapping ranges

* The range of the TINT value of the carbon black taught by Branan was calculated from the relationship of TINT/CTAB ratio of 0.80-1.10 with CTAB 120-160.

@ The range of the Dmode of the carbon black taught by Branan was calculated from) D50/Dmode ratio of 0.80-1.05 and) D50 of 70-100.

The claimed range of the Dmode (nm) was calculated from the relationship Dmode $ 218 - 1.12(TINT) wherein TINT is between 90-140.

We think it apparent, based on a review of Table **I**, that the carbon black recited in claim 1 bears close relationship to the carbon black disclosed by Branan. If there is any significant difference between these carbon black compositions, that difference could only be found in comparing values for the)D50/Dmode ratio.

Appellants recognize that the issue centers on whether the claimed)D50/Dmode ratio of 0.6 - 0.8 patentably distinguishes over the)D50/Dmode ratio of 0.8-1.05 disclosed by Branan. In the paragraph bridging pages 5 and 6 of the Appeal Brief, appellants argue that "the)D50/Dmode ratios disclosed by Branan exceed the values specified by the present claims, and the present specification, as advantageous for passenger car tires (emphasis added)." This is factually incorrect because the claimed range of 0.6 to 0.8 includes the lower limit of the)D50/Dmode ratio range disclosed in column 3, line 36 of Branan. Appellants do not come to grips with this specific disclosure of Branan, and do not appreciate that both ranges include the same end point, i.e., 0.8.

In the third full paragraph on page 5 of the Appeal Brief, appellants argue that Branan teaches carbon blacks intended for use in trucks and bus tires; and that the carbon blacks of the present invention, intended for use in passenger car tires, are patentably distinguishable therefrom. We disagree. Appellants' argument to the contrary,

notwithstanding, Branan's disclosure is not limited to carbon blacks for use in truck and bus tires. Branan discloses carbon blacks "suitable for various applications and particularly well suited for use in rubber compositions." (column 1, lines 9 through 12). In Branan, truck and bus tires are merely examples of a specific applied utility, i.e., Branan discloses "new rubber compositions, advantageous for use as truck and bus tires, incorporating the new carbon blacks" (column 1, lines 49 through 51, emphasis added). Branan, however, is not restricted to that applied utility or that use. As stated in In re Fracalossi, 681 F.2d 792, 794 n1, 215 USPQ 569, 570 n.1 (CCPA 1982), it is axiomatic that a reference must be considered in its entirety, and it is well established that the disclosure of a reference is not limited to specific working examples contained therein. Here, Branan is prior art not only for the teaching of the specific embodiment recited but for what it fairly teaches to a person having ordinary skill in the art.

In conclusion, we agree that the carbon black recited in claim 1 would have been prima facie obvious in view of the closely related carbon black disclosed by Branan. On this record, appellants do not rely on objective evidence of non-obviousness which would serve to rebut the prima facie case, e.g., objective evidence establishing that the

claimed invention possesses unexpectedly superior results compared with the closest prior art. Accordingly, we affirm the examiner's decision rejecting claim 1 under 35 U.S.C. § 103 as unpatentable over Branan.

As previously indicated, claims 2 through 8 fall together with claim 1.

One further point warrants attention. Notwithstanding the representation in appellants' brief (Paper No. 14, mailed June 28, 1995, paragraph bridging pages 1 and 2) that "there are no related appeals or interferences", we invite attention to Appeal No. 96-0150 in Application No. 07/969,244. In that related appeal, another merits panel of the Board reversed the examiner's rejection of claims 1 through 10 under 35 U.S.C. § 103. The available records in the Patent and Trademark Office indicate that a Notice of Allowance issued June 2, 1999, in the related appeal. In any further prosecution of the subject matter of this appeal, we recommend that the examiner reevaluate patentability in light of the subject matter disclosed and claimed in Application No. 07/969,244. For example, the examiner should consider entering rejections under 35

U.S.C. § 103 via 102(e) or for obviousness-type double patenting based on the subject matter disclosed and claimed in the related appeal.

The examiner's decision is affirmed.

AFFIRMED

SHERMAN D. WINTERS Administrative Patent Judge	)	
WILLIAM F. SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN D. SMITH Administrative Patent Judge	)	

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